REMARKS/ARGUMENTS

The rejections presented in the Office Action dated August 5, 2008, (hereinafter Office Action) have been considered but are believed to be improper because they are based upon a misinterpretation of the teachings of U.S. Publication No. 2002/0183062 to Kubosawa (hereinafter "Kubosawa"). Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the § 103(a) rejections, each of which is based at least in part upon a combination of the teachings of Kubosawa and those of U.S. Patent No. 6,556,840 to Zicker *et al.* (hereinafter Zicker), because the asserted references alone, or in combination, do not teach or suggest each of the claimed limitations. Contrary to the assertion at page three of the Office Action, Kubosawa does not teach preventing application of a handover algorithm to detect a need for a mobile terminal to change to another channel when a user interface component is inactive. Instead, when no input is detected in step S9 of Fig. 2 (asserted as corresponding to the claimed inactive state of a user interface component), Kubosawa's handover algorithm continues, *e.g.*, the algorithm continues to measure communication quality at step S4 for the handover operation. The relied-upon Fig. 2 of Kubosawa is a "flowchart showing handover operation of the mobile communication terminal". Thus, the asserted steps S8 and S9 are not for determining whether a handover <u>algorithm</u> is applied or not, but rather, they represent steps carried out during, or by, a handover algorithm execution. Since Kubosawa's handover operation illustrated in Fig. 2 continues to be performed even when no input is detected at step S9, Kubosawa does not teach preventing an algorithm from detecting a need for changing channels, as claimed.

The further reliance on the teachings of Zicker also fails to correspond to such limitations. While Zicker teaches that a remote party may send a deactivation command to a mobile station rendering the mobile station unusable to a user, there is no indication that the deactivation command would prevent application of a handover algorithm. Instead, in response to the deactivation command, user-active programming in the memory is overwritten with inactive programming (column 14, lines 26-29). After the overwriting,

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(task 166) the mobile station returns to operation in its inactive state (step 118 of Fig. 8, column 14, lines 29-33), which leads to scanning of radio channels and to selection of an appropriate channel (column 11, lines 17-25). Thus, Zicker's mobile station has not been prevented from applying a handover algorithm to detect a need to change channels. Moreover, Zicker has not been shown to teach preventing a handover algorithm application on the basis of checking the state (active or inactive) of a user interface component or doing so in response to detecting an inactive state of the user interface component. Thus, Zicker does not teach the limitations absent from Kubosawa. Without a presentation of correspondence to each of the claimed limitations, the § 103(a) rejections are improper.

In order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); and moreover, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). *See, e.g.*, MPEP § 2143.03. The Examiner appears to have ignored certain claim limitations such as those directed to preventing application of a handover algorithm to detect need for a mobile terminal to change to another channel in response to detecting that a user interface component is in an inactive state, which are not taught by either of the cited references. For example, Kubosawa does not teach preventing an algorithm from detecting the claimed need, and Zicker's deactivation command does not prevent the mobile station from operation in an inactive state, including selection of radio channels. Since neither of the asserted references teaches at least these limitations, any combination of Kubosawa and Zicker must also fail to teach such limitations thereby rendering the rejections improper. Applicant accordingly requests that each of the rejections be withdrawn.

In addition, as discussed previously Kubosawa teaches that when handover is needed and possible, handover is executed (paragraph [0032]). There is no indication that Kubosawa applies, or does not apply, a handover algorithm when a user interface component has been checked to be active. Rather, Kubosawa provides an opportunity for a user to predetermine the type of handover that may be performed such that if handover is determined

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determined to be necessary (based upon quality measurements) and the type of predetermined handover is possible (the predetermined system is available for handover), handover is executed. Steps S8 and S9 of Kubosawa's Fig. 2 are not directed to determining whether or not a handover algorithm is executed, but rather, are steps carried out during a handover algorithm execution when the execution . More specifically, step S9 merely checks for user input and if no input is received, the algorithm reverts to measuring the communication quality at step S3. Without a presentation of correspondence to each of the claimed limitations, the prior art rejections are improper.

Dependent Claims 2, 8, 10-12, 19, and 22-28 depend from independent Claims 1, 9, and 21, respectively, and each of these dependent claims also stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the above-discussed combination of Kubosawa and Zicker. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 9, and 21. These dependent claims include all of the limitations of their respective base claims and any intervening claims, and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2, 8, 10-12, 19, and 22-28 are also patentable over Kubosawa and Zicker.

Moreover, Applicant further traverses each of the § 103(a) rejections because the asserted modification of Kubosawa would improperly change the principle of operation of the teachings of Kubosawa. If a proposed modification would change the principle operation of the prior art being modified, then the teachings of the reference are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01(VI). Kubosawa teaches that handover operation (illustrated in Fig. 2) continues when input is not received from a user in step S9 and teaches that handover is executed when it is needed and possible (paragraph [0032]). Modifying Kubosawa to

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Modifying Kubosawa to prevent application of the handover operation when no input is received, would require Kubosawa's user to provide input every time handover is executed, not just when there is a problem in execution (*e.g.*, the predetermined system is not available). The asserted modification would prevent handover from being executed each time a user does not provide input, such that even if the problem were resolved, handover could not be executed once it is available. Also, conventional handover, option (1), would not be performed without a user input (paragraphs [0033]-[0038]). Kubosawa teaches away from preventing handover algorithm application when a device is in an inactive state and instead teaches that the algorithm of Fig. 2 is continued, with or without, input at step S9. The asserted modification of Kubosawa would change the principle operation of Kubosawa to require user input every time the mobile station executes handover. A skilled artisan would not make such a change, and the asserted modification fails to support the rejections. Applicant accordingly requests that the rejections be withdrawn.

With respect to the § 103(a) rejections of dependent Claims 3-7, 13-18, and 20 based upon Kubosawa and Wong in view of GB 2289191 by Motorola; U.S. Patent No. 6,178,388 to Claxton; U.S. Publication No. 2004/0204123 by Cowsky, III *et al.*; U.S. Publication No. 2004/0248594 by Wren, III; and U.S. Patent No. 6,871,074 to Harris *et al.*, respectively, Applicant respectfully traverses. As discussed above, Kubosawa and Zicker fail to correspond to the limitations of independent Claims 1 and 9 (from which Claims 3-7, 13-18, and 20 depend). The further reliance on these additional teachings does not overcome the above-discussed deficiencies in Kubosawa and Zicker. Thus, the asserted combinations of these teachings with the teachings of Kubosawa and Zicker do not teach each of the claimed limitations of dependent Claims 3-7, 13-18, and 20, and each of the § 103(a) rejections should be withdrawn.

It should also be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been inherent, obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to

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address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

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